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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 11/01/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,917

Applicant(s)

BATES ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Prosecution Reopened

In view of the Appeal Brief filed on August 13, 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claims Status

Claims 1-26 are pending. Claims 1-26 are rejected.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

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the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites “automatically designating one of the at least two frames as a default search frame.” The specification does not contain a clear and concise written description of the manner and process of making the above automatic designation such that a skilled artisan can make and use the invention. Paragraph 20 of Applicant’s specification states the following:

[0020] Embodiments of the present invention provide methods, systems and articles of manufacture for searching content in frames. In general, information located at one or more networked addresses may be displayed to a user in two or more frames. One of the frames may be automatically designated as a default search frame. Such a designation may be made according to a tag or other criteria, such as attributes of the frame itself or historical information pertaining to a previous search of one of the active frames. In any case, the designation of a default search frame eliminates the need for explicit selection by the user prior to a search.

Based on the above disclosure, the skilled artisan would not be able to make and use the invention because several possible instances of automatically designation are provided without providing an in-depth process of making a means of automatic designation. In particular, the method of automatically selecting a default frame from a plurality of frames and then coordinating the searching process with the selected default frame is not described in the specification.

Claims 8 and 16 recite wherein automatically designating comprises one of selecting from the at least two frames a frame containing a greater amount of content and selecting a largest frame from the at least two frames. The specification does not include a clear and concise description of the process of selecting a frame containing a greater content such that a skilled artisan can make and use the invention.

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Claims 10 and 21 include language similar to claim 1 and thus are rejected for reasons similar to claim 1. Claims 2-7, 9, 11-15, 17-20 and 22-26 are rejected for being dependent from a rejected base claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites in the preamble "at least two frames each containing searchable text." In the body of claim 1, the following claim language is included "automatically designating one of the at least two frames as a default search frame." The scope of the invention is difficult to ascertain because the above limitations are contradictory. It is unclear how the second frame can be searched when the first frame is automatically designated as the search frame or vice versa. When the first frame is designated as the default search frame, the second frame is not searchable, or vice versa.

Claims 10 and 21 contain language similar to claim 1 and are rejected for reasons similar to claim 1. Claims 2-7, 9, 11-15, 17-20 and 22-26 are rejected for being dependent from a rejected base claim.

Art Rejection Precluded

Claims 8 and 16 are rejected above under the first paragraph of 35 U.S.C. 112. No art rejection is provided in this office action.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 7, 10-13, 15, 18-21 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,449,624 issued to Hammack et al (hereafter Hammack), in view of US Pat No 6,542,515 issued to Kumar et al (hereafter Kumar), as best examiner is able to ascertain.

Claims 1, 10, 21 and 26:

Hammack discloses a method of formatting an electronic document comprising at least two frames [Fig 16, 222, 224] each containing searchable text, comprising:

- receiving a response containing the electronic document [Fig 16]
- a search frame [Fig 12, 232, 234, 236 and Fig 11]
- rendering the electronic document for display [Fig 16]

Hammack discloses the elements of claim 1 as noted above. Furthermore, Hammack discloses automatically selecting both frames [col 24, lines 53-60] but is silent regarding automatically designating one of the two frames as a default frame based upon a preexisting

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specification. Kumar discloses automatically designating a default frame from a plurality of frames [col 15, lines 10-16]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hammack to include automatically designating a default frame as taught by Kumar for the purpose of designating a frame containing the most current version [col 15, lines 10-16]. The ordinarily skilled artisan would have been motivated to improve the invention of Hammack by automatically designating a single default frame which includes the most current version such that the user can quickly and reliably ascertain which is the most current version. Positive identification of the most current version will assist in reducing user error.

Claims 2, 11, 13, 18 and 20:

Hammack discloses wherein the electronic document is a web page [col 9, lines 15-25], wherein the response is received from the Internet [col 8, line 8] and wherein at least the automatically designating and rendering are performed by a browser [inherent in Microsoft SQL Server [col 21, lines 30-32, XML document per col 22, lines 1-67]

Claims 3 and 19:

Hammack discloses wherein automatically designating occurs one of before rendering and after rendering [Fig 16 and col 24, lines 19-29].

Claims 4 and 12:

Hammack discloses wherein automatically designating occurs without an explicit selection of the default search frame by a user [Fig 16, col 24, lines 53-65].

Claims 6 and 15:

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The combination of Hammack and Kumar discloses wherein automatically designating comprises selecting from the at least two frames a frame previously selected for a content search [inherent in the disclosure of a default frame by Kumar].

Claim 7:

The combination of Hammack and Kumar discloses wherein automatically designating comprises selecting from the at least two frames according to an attribute of the at least two frames [inherent in the disclosure of a default frame which includes most recent information]

2. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hammack and Kumar and further in view of US Pat No 6,288,702 issued to Tachibana et al (hereafter Tachibana), as best examiner is able to ascertain.

Claim 5:

The combination of Hammack and Kumar discloses the elements of claim 1 as noted above. The combination of Hammack and Kumar fails to disclose wherein automatically designating comprises parsing the response to locate a default search frame identifier. Tachibana discloses wherein automatically designating comprises parsing the response to locate a default search frame identifier [Fig 4, 311, col 6, lines 1-5]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Hammack and Kumar to include wherein automatically designating comprises parsing the response to locate a default search frame identifier as taught by Tachibana for the purpose of guiding the user to a window which is currently available to the user for the input of characters or the like [col 5, lines 35-40].

Claims 9, 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hammack and Kumar and further in view of US Pat No 5,388,993 issued to McKiel et al (hereafter McKiel), as best examiner is able to ascertain.

Claims 9, 17 and 25:

The combination of Hammack and Kumar discloses the elements of claims 1 and 21 as noted above. The combination of Hammack and Kumar fails to disclose highlighting the default search frame. McKiel discloses highlighting the default search frame [col 3, lines 40-45, Fig 1, 25]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Hammack and Kumar to include highlighting the default search frame as taught by McKiel for the purpose of indicated an activated frame [col 3, lines 40-45]. The skilled artisan would have been motivated to improve the invention of the combination of Hammack and Kumar per the above for the purpose of assisting the user to identify a newly created frame [col 5, lines 1-10].

3. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hammack and Kumar in view of Pub No US 2002/0065110 issued to Enns et al (hereafter Enns).

Claim 14:

The combination of Hammack and Kumar discloses the elements of claim 10.

The combination of Hammack and Kumar fails to disclose wherein automatically designating comprises parsing the response to locate a default search frame tag.

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Enns discloses wherein automatically designating comprises parsing the response to locate a default search frame tag [paragraph 58].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Hammack and Kumar to include wherein automatically designating comprises parsing the response to locate a default search frame tag as taught by Enns.

The ordinarily skilled artisan would have been motivated to modify the combination of Hammack and Kumar per the above for the purpose of controlling the browser display [paragraph 58].

4. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hammack and Kumar in view of Pub No US 2003/0028850 issued to Quinn et al (hereafter Quinn).

Claims 22 and 23:

The combination of Hammack and Kumar discloses the elements of claim 21 as noted above.

The combination of Hammack and Kumar fails to disclose wherein the program is a browser and the default search frame code segment is an HTML tag.

Quinn discloses wherein the program is a browser and the default search frame code segment is an HTML tag [paragraph 68].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Hammack and Kumar to include wherein the program is a browser and the default search frame code segment is an HTML tag as taught by Quinn.

The ordinarily skilled artisan would have been motivated to modify the combination of Hammack and Kumar per the above for the purpose of providing a user with the ability to edit an electronic file [abstract].

5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hammack and Kumar and further in view of Pub No US 2002/0129064 issued to Guthrie (hereafter Guthrie).

Claim 24:

The combination of Hammack and Kumar discloses the elements of claim 21 as noted above.

The combination of Hammack and Kumar fails to disclose wherein the default search frame code segment is an attribute of a FRAMESET tag.

Guthrie discloses wherein the default search frame code segment is an attribute of a FRAMESET tag [paragraph 11].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Hammack and Kumar to include wherein the default search frame code segment is an attribute of a FRAMESET tag as taught by Guthrie.

The ordinarily skilled artisan would have been motivated to modify the combination of Hammack and Kumar per the above for the purpose of providing sufficient information to generate an instance of the injectable component [paragraph 11].

Response to Arguments

Applicant's arguments, filed in the Appeal Brief of 8/13/2004 with respect to claims 1-26 have been considered but are moot in view above new ground(s) of rejection. Nevertheless, examiner addresses the following comment on one of the **plurality of unnumbered pages** of the Appeal Brief.

Indeed, a careful analysis of the section cited by the examiner, illustrates why specifying that a hyperlinked web resource will be displayed in a target frame has no effect which could be construed as designating one of at least two frames as a default search frame. The pending claims provide a method for formatting an electronic document comprising at least two frames, each containing searchable text, See e.g. Claim 1). One of the at least two frames is designated as the default search frame (Id). The section by Krauss cited by the examiner refers to a first frame which contains textual description of the cultural habits of lion in the wild as a link to a video of lions in the wild (col 6, lines 23-38). The cited section states that when the user selects the link, a video of lions in the wild is displayed in a second frame(id.). Appellants respectfully submit that a video of lions in the wild contains no searchable text. If a target frame were construed to be equivalent to a default search frame, such a construction would render the cited section meaningless because a frame displaying a video of lions in the wild cannot be searched, since the frame contains no searchable text. Accordingly, the cited section does not refer to designating one of at least two frames as a default search frame.

Examiner is not persuaded. Supra office action rejects claim 1 under the first and second paragraphs of 35 U.S.C. 112. The specification fails to enable a skilled artisan to make and use the invention because the process of coordinating a search function with a default frame is not

clearly and concisely described. Coordinating a search function with a default frame is not trivial because the default frame can be either the first frame or the second frame.

Furthermore, claim 1 is indefinite because the scope of the invention cannot be determined. The preamble recites “two frames each containing searchable text.” The body of claim 1 recites “automatically designating one of the at least two frames as a default search frame.” It is clear that a first frame becomes searchable when it is designated as the default frame. It is unclear when and if the second frame becomes searchable. The scope of the invention is not ascertainable because it is unclear whether only the default frame is searchable or whether both the default frame and the non-default frame are searchable. Given this indefiniteness in the claim language, examiner maintains the contents of the non-default frame, i.e., text, audio or video is immaterial.

In the best interests of advancing prosecution, examiner has reopened prosecution and provided three references, each including at least two frames, each frame containing textual material. In particular, the disclosure of Hammack teaches that both frames are simultaneously automatically searchable. Examiner provides a secondary reference, i.e., Kumar, to modify Hammack’s simultaneous automatic selection of two frames to the automatic selection of a single default frame.

Examiner maintains that instant application does not contain patentable material. Applicant provides an extremely rudimentary summary of the invention in the Appeal Brief on one of the **plurality of unnumbered** pages. In fact, the summary of the invention is merely a duplication of claim 1. The process of tagging a frame to provide information regarding the frame such as a default frame, is well-known and expected in the art as disclosed by Hammack,

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Tachiban, Enns, Quinn, Guthrie and McKiel. Examiner finds it difficult to imagine how the designation of one of two text frames as a default frame can be considered patentable. In particular, the specification on page 3, discloses that user selection of a frame for searching is well-known and expected in the art. Therefore, at best, instant invention can be characterized as the automation of a manual process and such automation is not patentable.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- 1) US Pat No 6,009,429 issued to Greer et al discloses at least two frames containing searchable text.
- 2) US Pat No 6,736,642 issued to Bajer et al discloses at least two frames containing searchable text


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Etienne LeRoux

October 25, 2004.


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